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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/683,168	11/28/2001	Mitchell O. Stec	stec	7971
26496	7590	12/06/2004		
GREENBERG & LIEBERMAN 314 PHILADELPHIA AVE. TAKOMA PARK, MD 20912				
			EXAMINER WONG, STEVEN B	
			ART UNIT 3711	PAPER NUMBER

DATE MAILED: 12/06/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/683,168

Applicant(s)

STEC, MITCHELL O.

Examiner

Steven Wong

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 03 September 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 4,5 and 11 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 4,5 and 11 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_.

*Allowable Subject Matter*

1. The indicated allowability of claims 4, 5 and 11 is withdrawn in view of the reconsideration of the reference to Townsley (4,655,451) and the rejection under 35 U.S.C. 101. Rejections are set forth below:

*Claim Rejections - 35 USC § 103*

2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
3. Claims 4, 5 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Townsley (4,655,451). Regarding claims 4 and 11, Townsley discloses a golfer's aid wherein a user determines his maximum driving distance based on information obtained at a driving range (note Figure 4) and uses this information on each hole of a golf course by use of an overlay on a layout of the hole itself. As the user visits each hole of the golf course, he will obviously determine a constant yardage based on the maximum driving distance and the longest par four hole on the course and will choose a club accordingly. Attention is directed to column 4, lines 21-32 stating that an average distance and average range of dispersion are calculated for each club.

Regarding the limitation for renaming the club in a positive manner, the examiner takes Official Notice that it is well known in the golf industry to supply clubs with names that have positive connotations attached thereto. For example, "Big Bertha" and "Warbird" are names of golf clubs sold in the industry and have positive connotations associated therewith. Regarding the limitation for a method for subtracting the constant yardage from the total distance on each hole of the course, the examiner also takes Official Notice that it is well known in the art of golf

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for the golfer to mentally subtract the constant yardage for a particular club from the total distance of the hole. Attention is directed to Figure 1 of Townsley where the overlay is placed over the map of the golf hole. The map shows the layout of the golf hole and total distance from the tee to the cup. When the overlay of Townsley is placed on the tee (18), it would have been obvious to one of ordinary skill in the art to subtract the constant yardage from the total distance of the golf hole in order to calculate the remaining distance to the golf cup.

Regarding claim 5, as stated above, it would have been obvious to one of ordinary skill in the art to subtract the constant yardage from the total distance of the hole to select a particular golf club for use. Further, it would have been obvious to also include the maximum driving distance obtained by each club in selecting a particular club for the hole in order to account for the possibility of one hitting an ideal ball.

***Claim Rejections - 35 USC § 101***

4. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

5. Claims 4, 5 and 11 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The basis for this rejection is set forth in a two-prong test of:

- (1) whether the invention is within the technological arts; and
- (2) whether the invention produces a useful, concrete, and tangible result.

**[Technological Arts Analysis]**

For a claimed invention to be statutory, the claimed invention must be directed to a practical application within the technological arts. Mere ideas in the abstract (i.e., abstract ideas, law of

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nature, natural phenomena) that do not apply, involve, use, or advance the technological arts fail to promote the “progress of science and the useful arts” (i.e., the physical sciences as opposed to social sciences, for example) and therefore are found to be non-statutory subject matter. For a process claim to pass muster, the recited process must somehow apply, involve, use, or advance the technological arts.

In the present case, the claims merely recite a method directed towards determining performance trends in an effort to determine a risk factor for the purpose of assessing the risk of a facility.

The invention as claimed and disclosed merely involves the manipulation of abstract concepts (e.g. a persons background, weight numbers, etc.) on a paper form that does not involve the use of anything in the technological arts. The invention involves nothing more than a human making computations and manually recording the results of these computations on the form.

Furthermore, it is noted here that there is absolutely no disclosure of any practical application of this invention that involves the technological arts.

[Useful, Concrete and Tangible Analysis]

Additionally, for a claimed invention to be statutory, the claimed invention must produce a useful, concrete, and tangible results. See, e.g., *State Street Bank and Trust Co. v. Signature Financial Group In.*, 149 F.3d at 1373, 47 USPQ2d at 1601-02 (Fed. Cir. 1998). A process that consists solely of the manipulation of an abstract idea is not concrete or tangible. See *In re Warmerdam*, 33 F.3d 1354, 1360, 31 USPQ2d 1754, 1759 (Fed Dir. 1994). See also *In re Schrader*, 22 F.3d 290, 297-98, 30 USPQ2d 1445, 1461-62 (Fed. Cir. 1994).

In the present case, the claims do not produce a concrete result. The claims recite “a method for determining performance trends”, or “a method for improving the performance (or efficiency)”

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in a facility which involves the selection and assignment of factors and weight numbers (and other abstract concepts) which are very subjective in nature. One of ordinary skill in the art would not be able to arrive at a specific repeatable end result (especially determining a trend or improving performance) to any of the claimed methods without undue experimentation. This statement is evidenced by the extreme subjective nature of the claimed method steps. See also the examiner's undue experimentation analysis in the rejection set forth below under 35 U.S.C. 112 1<sup>st</sup> paragraph. Furthermore, the claims do not result in a tangible real or actual effect. The end result in each of the claims is any improved performance of the facility. Improved performance is not a tangible result that is evidenced by a real or actual effect. Improved performance in this case is merely the opinion of the user or performer of the method steps. For the reasons set forth above, the invention set forth in claims 4, 5 and 11 is not considered to be within any of the statutory classes of invention and therefore is not eligible for patent protection.

***Claim Rejections - 35 USC § 112***

6. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

7. Claims 4, 5 and 11 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Specifically, it does not appear as if the invention could be practiced to produce a concrete result without undue

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experimentation. The factors set forth for a determination of undue experimentation are set forth in MPEP 2164.01(a), following the analysis in *In re Wands*, 858 F.2d 731, 737, 8 USPQ2s 1400, 1404 (Fed. Cir. 1988). In this case, the examiner has considered each of these factors in arriving at the conclusion that the invention could not produce a concrete result without undue experimentation. The evidence in the application file has been considered for each of these factors as a whole and all of the factual considerations have been weighed. Specifically, the intended operation of the process is to improve facility performance. The factors used in the process are very subjective (assigning weight factors, etc.) with any result of the process being speculative at best. Applicant has not set forth any objective evidence or direction in the record that would lead one of ordinary skill in the art to be able to analyze these highly subjective factors and arrive at a specific, predictable result. the very low predictability of this invention due to the subjective nature of the elements used there, coupled with the lack of direction provided by the specification and the subjective nature of the invention far out-weigh all other "Wands" factors when considering the necessity for undue experimentation.

***Response to Arguments***

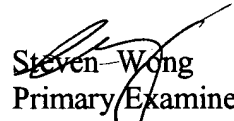
8. Applicant's arguments filed September 3, 2004 have been fully considered but are not deemed to persuasive. Amended claims 4 and 5 are now rejected under 35 U.S.C. 103 and 35 U.S.C. 101 as set forth above. The applicant's request for a telephone conference should the claims not be deemed to be allowable was noted. However, a telephone conference was not seen as being advantageous since the rejections are newly presented to applicant.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Steven Wong whose telephone number is 571-272-4416. The examiner can normally be reached on Monday through Friday 7am-3:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Greg Vidovich can be reached on 571-272-4415. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Steven Wong  
Primary Examiner  
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SBW  
December 3, 2004